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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/306,006	05/06/1999	ANDREAS WERNER SUPERSAXO	NB/2-21551/A	2914

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EXAMINER
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SHARAREH, SHAHNAM J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/306,006	<b>Applicant(s)</b> SUPERSAXO ET AL.	
	<b>Examiner</b> Shahnam Sharareh	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2,6,16-21,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,6, 16-21, 28-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

The Amendment filed on May 28, 2004 has been entered. Claims 2, 6, 16-21, 28-29 are now pending. Clarification of the status of claim 10 is requested. Applicant has treated this claim as being pending. However, Applicant has canceled this claim on June 06, 2003.

Any rejection that is not addressed in this Office Action is considered obviated in view of the Amendments.

### ***Response to Arguments***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 6, 16-21, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yiv et al US Patent 6,245,349 in view of Weder WO 96/37192.

Applicant's arguments with respect to this rejection have been fully considered but are not persuasive.

Applicant argues that neither of the cited references teach the use of the instantly claimed polyoxyethylene co-emulsifiers. Applicant further argues that the primary and the secondary references use polyethoxylated sorbitan fatty ester which is excluded from the instant claims 28-29 because it is not a polyethoxylated carbohydrate, rather a fatty acid derivative thereof.

In response Examiner states that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800

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F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, the rejection is based on the combined teachings of the references and whether the instant claims are obvious in view of such teachings. Examiner believes the instant claims are obvious for the reasons of record.

First, Applicant's arguments that the primary reference does not specifically use the polyoxyethylene coemulsifier is not persuasive, because the Yiv clearly set's forth other functional equivalents that can be used as his polyoxyethylene coemulsifier component. For example, at col 6, lines 6-36, Yiv describes the proper criteria for suitable coemulsifiers. Specifically Yive provides for their HLB values and recites numerous surfactants within the scope of the instant claims. i.e. polyoxyeethylene stearates, polaxomers, ethoxylated casor oils, sodium oleate.

Second, Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, clearly the art characterizes the use of various polyethoxylated coemulsifier with high HLB to possess interchangeable properties. Even Applicant in his own specification at page 6, characterizes all such polyoxyethylene type coemulsifiers to be interchangabe in this art. More specifically nearly all of the examples in the instant specification has used polyoxyethylene sorbitan fatty esters, polysorbate 80, (Tween 80), as their main

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coemulsifier. This is the same emulsifier used by Weder and Yiv. Therefore, there was ample knowledge in the art available to one of ordinary skill in the art that polyethylene coemulsifiers recited in the instant claims would act similar to the Tween 80 used by Yiv and Weder.

Finally, Examiner states that interpreting the scope of the instant claims in their broadest reasonable interpretation, the Applicant's assertion that the polyoxyethylene sorbitan fatty acid of Yiv is excluded in the instant claims is not accurate.

Polyoxyethylene sorbitan fatty acid is a derivative of a polyethoxylated carbohydrate, sorbitol. Sorbitol is a sugar alcohol, thus, the Tween 80 is a derivative of polyethoxylated carbohydrates and it falls within the genus of polyoxyethylene carbohydrates. Further, the instant specification does not clearly set forth the scope of the instant limitation, Polyoxyethylene carbohydrates. Therefore, Tween 80 is viewed to be a polyoxyethylene carbohydrates within the scope of the instant claims.

Therefore, the claims stand rejected for the reasons of record.

***Declaration filed under 37 CFR 1.132 By Dr. Supersaxo***

The declaration under 37 CFR 1.132 filed May 28, 2004 is insufficient to overcome the rejection of claim 2, 6, 15-21, 28-29 based upon the rejection as set forth in the last Office action.

The scope of the declaration is not commensurate with the scope of the claims, because it does not provide sufficient evidence of unexpected results. The declaration presented evaluates the nanoparticles of the prior art, sample 1, with those of the

instant invention, samples 2-5. The declaration then concludes that the particle size created by prior art is larger than those created according to the invention.

In response, Examiner states again that the nanoparticles of the prior art both in Yiv and Weder, still create a particle size and appearance characteristics that is within the scope of the instant claims. they both create a opalescent, transparent and homogenous formulation having particle size smaller than 50nm. The instant claims such characteristics and particle size. The declaration provided reinforces such teaching of prior art. The fact that particle size of samples 2-5 is smaller than 15 nm is not relevant because the scope of the instant claims is not directed to such particle sizes. Therefore, no evidence of unexpected results are presented.

### ***Conclusion***

**No claims are allowed. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

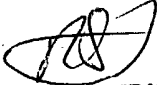
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 571-272-0630. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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